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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,332	07/01/2004	David S. Bonalle	70655.3000	4331
20322	7590	05/03/2006	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 85004-2202			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/710,332

Applicant(s)

BONALLE ET AL.

Examiner

Daniel I. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Receipt is acknowledged of the pre-amendment received on 19 April 2006.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for different accounts, does not reasonably provide enablement for the first and second user accounts being associated with different users.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Claim 21 recites first and second user accounts are from different users. However, the specification teaches that the sample is of one user (paragraph [0245]), which teaches the accounts are from the same user.

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-16 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Re claim 1, the claim recites the biometric sample is associated with a preset transaction limitation independent of any limitation associated with said account. The Examiner notes that this is vague/indefinite, because the Examiner believes that the transaction limitation associated with the biometric is related, albeit different, to an account limitation. For example, a transaction limitation of the biometric cannot exceed a transaction limitation of the card (credit limit), so it is unclear on how the transaction limitation of the biometric is independent from the account limitations, if the biometric must conform and not exceed the maximum credit line available, for example. The Examiner has interpreted the limitations as the biometric is not merely associated by extension to a transaction limitation of the card (credit limit of the card) but provides a level of security (required for certain purchases).

Re claim 20, it is unclear how a first biometric sample is primary associated with a first account and a second sample is secondarily associated with a second account, if the users are different. If the users are different, the associations would be independent, and therefore it is unclear how different samples would be primarily and secondarily associated if the users are different. They would appear to be just associated, not primarily and secondarily, since the users are unique. The Examiner for purposes of Examination has interpreted this as two users with different respective accounts, as is conventional.

Appropriate clarification/correction is required.

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as cited in the previous Office Action, in view of Baer (US 2005/0232471).

Re claim 1, Black teaches receiving a proffered biometric sample at a sample receiver, receiving user information at the sample receiver (FIG. 1a, FIG. 5A, abstract); associating the biometric sample with user information to create a data packet (FIG. 10A-11, 14A). The user information is interpreted as a data packet that associates user information, biometric information. Though silent to associating smartcard information, the Examiner notes that it has been discussed in the previous Office Action that Black teaches that transponders and smartcards are possible embodiments of the invention. As Black teaches that the transponders have a unique identifier/customer number associated

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with the data (interpreted as packet (FIG. 10+ and 14+), it would have been obvious for the smartcard to have a unique customer number or serial number for identification purposes. Such unique identifying means server as a well-known and conventional means to identify and provide security of the system. Accordingly, it would have been obvious to one of ordinary skill in the art to receive the unique identifier and associate it with a data packet as a means to authenticate and verify the smartcard.

Black is silent to the biometric sample being associated with a preset transaction limitation independent of a financial account limitation.

Baer teaches such limitations (paragraph [0037]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baer.

One would have been motivated to do this in order to have different levels of security for different transactions.

Re claim 2, Black teaches contacting an authorized sample receiver through at least one of a computer, Internet, software, hardware, third party biometric entity, kiosk, biometric registration terminal, and communication device (FIG. 5A). It is clear that during reception of the sample that the receiver is in contact with one of the listed devices, in order to receive the sample.

Re claim 3, Black teaches that receiving of the sample includes at least one of processing, storing, comparing, and verifying the sample as a record is created (FIG. 14A). Additionally, the Examiner notes it would have been obvious to one of ordinary skill in the art to process/store/compare/verify the sample as such means are conventional

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in the art to authenticate a sample (that is real), and put it into a format that can be recognized for accessing and verifying a user.

Re claim 4, it has been discussed above that the proffered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information (also see FIG. 10A-11B, FIG. 14A).

Re claim 5, Black teaches (FIG. 1A) that the data can be stored on a host computer or on the transponder itself (paragraph [0090]), which is interpreted as being contained in at least one of a smartcard, a smartcard reader, a sensor, a remote server, a merchant server, and said smartcard system, as Black teaches that the invention can take form of a smartcard, transponder, other device (abstract for example). Though silent to a database, Black teaches remote or local storage. As a database is a well know and conventional means to store and organize data, its use would be an obvious expedient to store the data packet at one of the locations set forth, depending on the desired security, for example.

Re claim 6, Black teaches (FIG. 5A) that one of more biometric sample is registered.

Re claim 7, the Examiner notes it would have been obvious that different samples (from different people) would be associated with different information from those others who are registered in the system, to provide a system usable by more than one person, as is conventional in the art.

Re claims 9 and 10, the Examiner notes that as Baer teaches different samples from the same user, the Examiner notes it would have been obvious that the multiple

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samples are associated with such different information (accounts), in order to comply with the security levels taught above, for example.

Re claim 10 and 11, as discussed above, it would have been obvious to one of ordinary skill in the art to associate different samples with different information in instances where there are multiple users of the system, for unique identification.

Re claim 12, it is interpreted by the Examiner that Black authenticates a user by the biometric sample and signature matching. This is interpreted as a secondary security feature. Additionally, the Examiner notes that secondary security features are well known and conventional in the art to verify that a sample is real (not fake) to increase security (for example, temperate or blood flow sensing).

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]).

Re claim 14, the Examiner notes that it has been taught above and in the previous Office Action that the same is received at one of a local database, remote database, portable storage device, host system, etc. as recited in the claim.

Re claim 15, a fingerprint scan has been discussed above (see Black for example).

5. Claims 8, 9, 16, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of de Sylva.



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The teachings of Black/Baer have been discussed above.

Black/Baer are silent to primary and secondary association as claimed.

De Sylva teaches such limitations (record 30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of de Sylva for convenience of the user, by setting primary and secondary accounts based on user preferences.

Re claim 9, the limitations have been discussed above re claim 8, where different users have different samples associated. Additionally, Baer as discussed above, teaches different samples of users for different types of transactions, where the samples are from the same user.

Re claim 16, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

Re claims 18 and 21, the Examiner notes that as charge levels are assigned to accounts based on price that is interpreted as a maximum transaction amount. Additionally, maximum amounts (credit lines) are conventionally associated with credit cards for user protection.

6. Claims 8, 9, 16, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of Moebs et al. (US 2005/0065872).

The teachings of Black/Baer have been discussed above.

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Black/Baer are silent to primary and secondary association as claimed.

Moebs et al. teaches such limitations (paragraph [0071]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of Moebs et al., for overdraft protection.

Re claim 9, the limitations have been discussed above re claim 8, where it is understood that different users have different samples associated. Additionally, Baer as discussed above, teaches different samples of users for different types of transactions, where the samples are from the same user.

Re claim 16, the Examiner notes that it is well known and conventional that credit cards can have associated limits/line of credits. It would have been obvious to associate the biometric with the limit, via extension, as it is used in conjunction with the card having a limit. One would have been motivated to do this to maintain the protection of the card (credit limit).

Re claims 18 and 21, the Examiner notes that as charge levels are assigned to accounts based on price that is interpreted as a maximum transaction amount. Additionally, maximum amounts (credit lines) are conventionally associated with credit cards for user protection.

#### ***Additional Remarks***

7. The Examiner notes that PINs associated with biometrics are well known and conventional for increased security (versus just a biometric; see US 2001/0029493, 5,764,789, 2004/0084524, 2002/0174067, 2002/0062284, 2001/0018660, which show

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that a PIN and biometric can be used together, for additional security over just a PIN or biometric, for example). The Examiner also notes Royer et al. (US 2004/0155101) teaches the use of different biometrics with multiple accounts and Ramachandran (US 2001/0013551) and Pitroda (US 6,925,439) which teach consolidation of card accounts onto one card for convenience.

The Examiner notes that different levels of security are well know and conventional in the art. For example, Deo et al. (US 5,721,781) teaches based on transaction amounts, different information is required in order to provide security/assurance that the user is valid (see Fig. 9), Rasmussen et al. (US 6,834,795) teaches similar teachings (FIG. 5), and Tetro et al. (US 6,095,413) teaches added security trough use of a separate databases).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Deo et al. (US 5,721,781), Rasmussen et al. (US 6,834,795), and Tetro et al. (US 6,095,413).

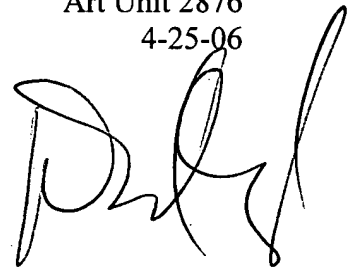
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh  
Examiner  
Art Unit 2876  
4-25-06

A handwritten signature in black ink, appearing to read 'D. I. Walsh', is written over the printed name and date.